

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW J. KEENAN

Appeal No. 98-2122
Application No. 08/607,886¹

ON BRIEF

Before MEISTER, NASE, and GONZALES, ***Administrative Patent Judges.***

MEISTER, ***Administrative Patent Judge.***

DECISION ON APPEAL

¹ Application for patent filed February 27, 1996. According to appellant this application is a continuation of Application No. 08/323,882, filed October 17, 1994, now abandoned.

Andrew J. Keenan (the appellant) appeals from the final rejection of claims 1-8, 10-14 and 18-24, the only claims remaining in the application.

We REVERSE and, pursuant to our authority under the provisions of 37 CFR § 1.196(b), enter new rejections of claims 1, 2 and 18 under 35 U.S.C. § 102(b) and claims 1-5, 12-14 and 18-24 under 35 U.S.C. § 103.

The references relied on by the examiner are:

Pickett 1978	4,111,401	Sep. 5,
Myers et al. (Myers) 1993	5,202,132	Apr. 13,

Additional references of record relied on by this merits panel of the Board are:²

Hilsey 1981	4,290,246	Sep. 22,
Collins 1995	5,404,685	Apr. 11,

(filed Aug. 31, 1992)

Claims 1, 2, 4-7 and 18 stand rejected under 35 U.S.C.

² "Although no "Notice of References Cited by Examiner" (PT0-892) is present in parent application Serial No. 08/323,882, the references to Hilsey and Collins were apparently made of record (but not relied on) in the Office action dated July 14, 1995 (Paper No. 3) of the parent application.

§ 103(a) as being unpatentable over Myers.

Claims 3, 8, 10-14 and 19-24 stand rejected under 35
U.S.C.

§ 103(a) as being unpatentable over Myers in view of Pickett.

As a preliminary matter, we base our understanding of the appealed subject matter upon the following interpretation of the terminology set forth in the claims (as they appear in the appendix to the brief). With respect to claims 13 and 14, in lines 4 and 8 of claim 13, and line 7 of claim 14, we interpret "mounting block" to be -- mounting post --. With respect to claim 18, in lines 14 and 17 we interpret "the first mounting post" to be -- the mounting post --; in lines 15 and 16 we interpret "the first panel" to be -- the panel --; and in line 16 we interpret "the notch" to be -- the notch end --.

Each of the above-noted rejections is bottomed on the examiner's position that:

It . . . would have been obvious to one having ordinary skill in the art to center Myers's [sic, Myers'] panel section one [sic, on] the post section, so that a more aesthetically pleasing, physically balanced wall section would be created; note that centering the panel with respect to the post provides a functionally equivalent wall structure, since the interconnection of adjacent wall sections is not affected by "shifting" the location of the panel from

an extreme left or right side to the center -- the adjacent panels still interconnect in the required tongue-and-groove manner, and the resultant wall still serves as a noise barrier. [Answer, page 5.]

We will not support the examiner's position. Obviousness under § 103 is a legal conclusion based on **factual evidence** (*In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)) and it is well settled that, in order to establish a **prima facie** case of obviousness, the prior art teachings must be sufficient to suggest to one of ordinary skill in the art making the modification needed to arrive at the claimed invention (*see, e.g., In re Lulu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984)). The examiner, however, has provided no factual evidence whatsoever in support of the position that it would have been obvious to center the wall with respect to the mounting post. As the court in *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968) stated: "A rejection based on section 103 must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. . . . [The examiner] may not . . . resort to speculation, unfounded assumptions or hindsight

reconstruction to supply deficiencies in . . . [the] . . . factual basis." As to the examiner's contention that the proposed modification would provide a "functionally equivalent" wall structure, it is well settled that equivalency does not establish obviousness. **See In re Scott**, 323 F.2d 1016, 1019-20, 139 USPQ 297, 299-300 (CCPA 1963) and **In re Flint**, 330 F.2d 363, 367-68, 141 USPQ 299, 302 (CCPA 1964).

With respect to claims 3, 8, 10-14 and 19-24, we have carefully reviewed the teachings of Pickett but find nothing therein which would overcome the deficiencies of Myers that we have noted above.

Both of the above-noted rejections are reversed.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejections:

Claims 1, 2 and 18 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hilsey. Initially we note that the terminology in a pending application's claims is to be given its broadest reasonable interpretation (**In re Morris**, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) and **In re Zletz**, 893 F.2d 319, 321, 13 USPQ2d, 1320, 1322 (Fed. Cir.

1989)) and limitations from a pending application's specification will not be read into the claims (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1989)). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. *See Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently (*see Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997)); however, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (*see Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983)). It is also well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists regardless of whether

there was a recognition that it could be used to perform the claimed function. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). **Note also** *LaBounty Mfg. v. Int'l Trade Comm'n*, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992).

Here, Hilsey discloses a wall including first and second panels (see, e.g., Figs. 1 and 2) which are assembled in a fashion similar to a tongue and groove structure (see Figs. 2, 7 and 9a; col. 2, lines 5-7). The panel members are provided with a grid-work of embedded reinforcing bars or rods placed on approximately 14 inch centers (see col. 5, lines 11-14), which grid-work would include both vertical and horizontal bars. Noting that independent claims 1 and 18 set forth that the mounting post may be one times the width of the panel (i.e., the **same** width as the panel), the end of the panel containing the groove and at least one vertical reinforcing rod can be considered to be the "mounting post" as broadly claimed. As to the limitation that the wall is a "noise abatement" wall, the wall of Hilsey clearly has the capability of being used as a noise abatement wall (**see In re Schreiber, supra**) and whether

Hilsey's wall actually is or might be used as such a wall depends upon the performance or non-performance of a future act of use, rather than a structural difference in the claims. Stated differently, the wall of Hilsey would not undergo a metamorphosis to a new wall simply because it was used as a noise abatement wall. **See *In re Pearson***, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) and ***Ex parte Masham***, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987).

As to the limitation in claim 18 that the panel and mounting post are vertically cast, claim 18 is directed to a product (i.e., a wall section), and not to the method of making the product. Thus, notwithstanding the "product-by-process" recitation of "vertically cast," the determination of the patentability of claim 18 is based on the wall section itself. That is, the wall section defined by claim 18 is anticipated if it is the same as the wall section of Hilsey, even if Hilsey's wall section was made by a different process. **See *In re Thorpe***, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claims 19-22 are rejected under 35 U.S.C. § 103 as being unpatentable over Hilsey. With respect to the embodiment of

Fig. 14a, Hilsey states that the panels may also include internal reinforcing in the form of "metallic mesh" which is "similar to metal fencing material" (col. 11, lines 39-42). Noting that the issue of obviousness is not only determined by what the references expressly state but also is determined by what they would fairly suggest to those of ordinary skill in the art (*see, e.g., In re Delisle*, 406 F.2d 1386, 1389, 160 USPQ 806, 808-09 (CCPA 1969) and *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969)), we are of the opinion that this disclosure by Hilsey would have fairly suggested "wire" reinforcement as claimed.

Claims 1-5, 12-14 and 18-24 are rejected under 35 U.S.C. § 103 as being unpatentable over Myers in view of Collins. As set forth on pages 4 and 5 of the answer, Myers discloses substantially all the limitations set forth (including a mounting post having a notch to receive the notch end of the panel so as to form a tongue and groove-type connection wherein the width of the mounting post relative to the width of the panel is within the claimed range - see Figs. 5 and 6)³ with the

³ *See Ex parte Lee*, 31 USPQ2d 1105, 1106 (Bd. Pat. App. & Int. 1993) and *Titanium Metals Corp. of America v. Banner*, 778

exception of the panel being centered with respect to mounting post. Collins, however, teaches a wall structure (col. 1, line 67) having a mounting post 30 and a panel 20 wherein the notch end of a panel is received in a notch in the mounting post so as to form a tongue and groove-type connection. Collins also teaches that the panel should be centered with respect to the mounting post (see, e.g., Fig. 5). The width of the mounting post relative to the width of panel (like the primary reference to Myers) appears to be within the claimed range (see Figs. 5 and 11). A combined consideration of Myers and Collins would have fairly suggested to the artisan to modify the appearance of Myers' wall (wherein the center of the panel is offset from the center of the mounting post such that the mounting post and panels are flush on one side and the mounting posts protrude on the other side) in order to achieve a more traditional fence-

F.2d 775, 782, 227 USPQ 773, 779 (Fed. Cir. 1985): "It is also an elementary principle of patent law that when, as by a recitation of ranges or otherwise, a claim covers several compositions, the claim is 'anticipated' if **one** of them is in the prior art." Note also the court's analysis in ***In re Woodruff***, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990) concerning the need to show criticality for a claimed range in order to establish obviousness. Here, page 6 of the specification merely indicates that the range is preferred.

like appearance (wherein the centers of the mounting post and panel are aligned such that the mounting posts protrude from both sides, thus creating a uniform appearance when viewed from either side) as taught by Collins.

Apparently anticipating a rejection based upon the combined teachings of Meyers and Collins (a rejection which, as we have noted above, was never made, the appellant in the parent application argued that:

Assuming for the sake of argument, that Collins is applied to the claims in singly or in combination with Myers et al., applicant's invention is still not taught. Firstly, Collins has a post with two panels mounted on each side thereof. The panels must then be clipped to the post with additional devices 40. Such devices 40 of Collins are not required or used by either Myers et al. or applicant. Secondly, to use such devices would destroy the function of both Myers et al. wall and applicant's wall. Devices 40, 41, 42 and 43 alone renders Collins inapplicable to applicant's wall.

Furthermore, devices 40 et al. alone mitigate against the combination of Myers et al. and Collins. The Collins post is hollow, stands alone, and receives a panel on each side. Myers et al. has a post incorporated in the panel. Modifying either structure to incorporate the other would destroy their function.

Even assuming for the sake of argument that the combination of Myers et al. and Collins is possible, applicant's invention still is not taught. No reference or reasonable combination thereof shows

applicant's coplanar, single unit, post and panel combination being assembled into a wall. [See page 11 of the amendment filed on September 25, 1995 (Paper No. 5) of the parent application.]

We are unpersuaded by the appellant's arguments. In order to establish obviousness under § 103, it not necessary that all of the features of the secondary reference be bodily incorporated into the primary reference (***see In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)) and the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment (***Lear Siegler, Inc. v. Aeroquip Corp.***, 733 F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984)). Here, the secondary reference to Collins is merely being used as a suggestion to center the panel relative to the mounting post as claimed.

In summary:

The examiner's rejections of claims 1-8, 10-14 and 18-24 under 35 U.S.C. § 103(a) are reversed.

New rejections of claims 1, 2 and 18 under 35 U.S.C. § 102(b) and claims 1-5, 12-14 and 18-24 under 35 U.S.C. § 103 have been made.

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED
37 CFR § 1.196(b)

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
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)	INTERFERENCES
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